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In re Application of EIDELMAN et al
U.S. Application No.: 09/807,680
Int. Application No.: PCT/IL99/00583
Int. Filing Date: 02 November 1999
Priority Date: 02 November 1998
Attorney Docket No.: U013399-2
For: APPARATUS AND METHOD FOR
FABRICATING FLAT WORKPIECES

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DECISION

This is in response to applicant's "Request for Corrected Notification of Missing Requirements" filed 27 June 2001 and "Transmittal of Supplemental Declaration" filed 04 September 2001.

BACKGROUND

On 02 November 1999, applicants filed international application PCT/IL99/00583, which claimed priority of an earlier Israel application filed 02 November 1998. A copy of the international application was communicated to the USPTO from the International Bureau on 11 May 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 25 May 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 02 May 2001.

On 16 April 2001, applicants filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1) and a preliminary amendment which reduced the number of claims.

On 18 May 2001, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date and additional claim fees in the amount of \$3,272.00.

On 27 June 2001, applicants filed the present request for a corrected Notification of Missing Requirements along with an executed declaration.

On 16 July 2001, applicants filed a supplemental preliminary amendment which further reduced the number of claims.

On 18 July 2001, the DO/EO/US mailed a Notification of a Defective Response (Form PCT/DO/EO/916) and a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917), which indicated that the declaration filed 27 June 2001 is improper because it does not identify the same named inventors as those listed in the international application.

On 04 September 2001, applicants filed a supplemental declaration.

DISCUSSION

I. Claim Fees

MPEP 607 states in relevant part,

An amendment canceling claims accompanying the papers constituting the application will be effective to diminish the number of claims to be considered in calculating the filing fees to be paid. A preliminary amendment filed concurrently with a response to a Notice To File Missing Parts of Application that required the filing fees, which preliminary amendment cancels or adds claims, will be taken into account in determining the appropriate filing fees due in response to the Notice To File Missing Parts of Application.

In the present case, the 16 April 2001 preliminary amendment and the 16 July 2001 supplemental preliminary amendment will be taken into account in determining the appropriate filing fees. A review of the application file reveals that applicants have submitted sufficient claim fees, and thus no additional claim fees are due.

II. Declaration


The declaration filed 04 September 2001 is acceptable with respect to inventor Doron Eidelman. Proper declarations executed by the remaining three inventors have not been submitted, and thus a complete and proper response to the Notification of a Defective Response has not been received.

CONCLUSION

For the reasons set forth in §I above, the Notification of Missing Requirements (Form PCT/DO/EO/905) mailed 18 May 2001 is VACATED with respect to the additional claim fees.

A proper response to the Notification of a Defective Response (Form PCT/DO/EO/916) must be filed within the time limit set therein.

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.


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